

REMARKS

In the final Office Action, the Examiner stated that, "This action is made **FINAL**, as necessitated by amendment." Applicants respectfully traverse and respectfully submit that the action should not have been made final.

Applicants respectfully submit that M.P.E.P. § 706.07(a) states, "Under present practice, second or any subsequent actions on the merits shall be final, except where the Examiner introduces a new ground of rejection that is neither necessitated by Applicants' amendment of the claims, nor based on information submitted in an information disclosure statement."

Since the Examiner found new art that has been used to reject Claims 5-8, the action should not be made final, since the new ground of rejection was not necessitated by Applicants' amendment, nor based on information submitted in an IDS, Claims 5-8 were previously indicated as allowable, and were not amended in the Response filed October 28, 2002.

Applicants respectfully request that the Examiner withdraw the finality of the action.

In the Office Action, the Examiner stated that the Declaration under 37 C.F.R. § 1.132, filed October 28, 2002, does not provide evidence of unexpected results for newly added claims 9-12 over the Miyasaka reference (U.S. Patent No. 5,869,208) ("Miyasaka"). Applicants respectfully traverse, and respectfully submit that the Declarations filed October 28, 2002, do provide evidence of unexpected results.

M.P.E.P. § 716.02(b) provides that, "Evidence of unexpected properties may be in the form of a direct or indirect comparison of the claimed invention with the closest prior art which is commensurate in scope with the claims."

For example, the Declaration prepared by inventor Dong-Gon Park stated that, "In contrast to my invention, Miyasaka coats a protective layer on the outside of the protective electrode after the positive electrode has been formed . . . I have conducted

experiments to compare the performance characteristics of my invention compared to the structure taught in Miyasaka. The coating procedure of my invention gives surprisingly better cycle life characteristics compared with the coating procedure taught in Miyasaka." Inventor Dong-Gon Park then attached a graph presenting the superior performance characteristics of his invention as compared with Miyasaka.

Applicants respectfully submit that the Declarations meet the requirements of M.P.E.P. § 716.02(b) as providing evidence of unexpected properties.

In the Office Action, the Examiner rejected Claims 5, 6, and 9-11 under 35 U.S.C. § 102(a) as being anticipated by Takeuchi et al. (WO 99/05734) ("Takeuchi").

Takeuchi was published February 4, 1999. Applicants are attaching hereto a Declaration establishing an invention date of the above-captioned application prior to February 4, 1999. In addition, Applicants respectfully submit that Takeuchi does not teach or suggest the desirability of the invention as claimed in Claims 5, 6, and 9-11.

Applicants respectfully request that the Examiner withdraw the rejection to Claims 5, 6, and 9-11 as being anticipated by Takeuchi.

In the Office Action, the Examiner rejected Claims 9 and 11 under 35 U.S.C. § 102(e) as being anticipated by Fujino et al. (U.S. Patent No. 6,428,766) ("Fujino").

Fujino was filed on October 25, 1999. Applicants are filing herewith a Declaration establishing an invention date of the above-captioned application prior to October 25, 1999. In addition, Applicants respectfully submit that Fujino does not teach or suggest the desirability of the invention as claimed in Claims 9 and 11 of the above-captioned application.

Applicants respectfully request that the Examiner withdraw the rejection to Claims 9 and 11 as being anticipated by Fujino.

In the Office Action, the Examiner rejected Claims 9-12 under 35 U.S.C. § 102(e) as being anticipated by Miyaki et al. (U.S. Patent No. 6,365,299) ("Miyaki"). Applicants respectfully traverse the rejection.

In the Office Action, the Examiner stated that Miyaki teaches, "a protective layer is provided on the negative electrode and/or the positive electrode." In contrast, Applicants' independent Claim 9 recites "a metallic oxide coated on each of the active material particles." The differences in performance between a protective layer on the electrode and a coating on each of the materials were demonstrated in the Declarations filed October 28, 2002, which were referenced above. Those Declarations are equally applicable here.

Applicants respectfully request that the Examiner withdraw the rejections to Claims 9-12 as being anticipated by Miyaki.

In the Office Action, the Examiner rejected Claims 1-4, 7-8, and 12 under 35 U.S.C. § 103(a) as being unpatentable over Amatucci et al. (U.S. Patent No. 5,674,645) ("Amatucci") in view of Takeuchi. Applicants respectfully traverse the rejection.

Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness in the rejection. In addition, Applicants respectfully submit that Takeuchi is not prior art to the above-captioned application in view of the Declarations being filed herewith, discussed above.

Applicants respectfully request that the Examiner withdraw the rejection to Claims 1-4, 7-8, and 12 as being unpatentable over Amatucci in view of Takeuchi.

In the Office Action, the Examiner rejected Claims 1-4 under 35 U.S.C. § 103(a) as being unpatentable over Amatucci in view of Miyasaka. Applicants respectfully traverse the rejection.

In the Office Action, the Examiner stated that, "Amatucci does not explicitly teach that the lithium manganese oxy-fluoride positive electrode material is coated with a metallic oxide." Applicants respectfully submit that Amatucci does not teach or suggest the desirability of coating the positive electrode material with a metallic oxide. Applicants respectfully submit that there is no motivation or suggestion to combine the coating of Miyasaka with the positive electrode material of Amatucci. Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness.

Applicants respectfully request that the Examiner withdraw the rejection to Claims 1-4 as being unpatentable over Amatucci in view of Miyasaka.

CONCLUSION

In view of the foregoing, it is believed that all claims now pending patentably define the subject invention over the prior art of record and are in condition for allowance, and such action is earnestly solicited at the earliest possible date.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2666 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17, particularly, extension of time fees.

Respectfully submitted,

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Dated: 6/17/03



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CERTIFICATE OF FACSIMILE

I hereby certify that this paper is being facsimile transmitted to the Patent and Trademark Office on the date shown below.

William E. Hickman



Signature Date

June 17, 2003